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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,125	04/19/2000	Joseph M. Cannon	1298/OF148	3933

7590

12/05/2003

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/553,125

Applicant(s)

CANNON ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2003 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Horan (US 6,347,136).

Regarding **claim 1**, Horan discloses calling party announcement methods (column 1, lines 6-9), (which reads on claimed “a method for communicating an audio message (column 4, line 19 “audio message”) between a calling telephone apparatus (column 4, line 20 “calling party”) and a called telephone apparatus (column 4, line 20 “called party”) while the called telephone apparatus remains in an on-hook state (column 4, line 21 “before the called party answers”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system”), the method comprising the step of:

introducing a digitized version of the audio message (column 4, line 25 “an ICLD signal”) to the called telephone apparatus while the called telephone apparatus remains in the on-hook state (column 4, lines 25-49) [The ICLD signal is detected between ring signals before the called party answers the phone].

Regarding **claim 2**, Horan discloses introducing a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 4, lines 25-49).

Regarding **claim 3**, Horan discloses wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins (column 4, lines 25-49).

Regarding **claim 4**, Horan discloses the calling party able to control (i.e. making calls) an audio message to be announced to the called terminal (column 1, lines 6-9), (which reads on claimed “a method for communicating an audio message (column 4, line 19 “audio message”) between a calling telephone apparatus (column 4, line 20 “calling party”) and a called telephone apparatus (column 4, line 20 “called party”) while the called telephone apparatus remains in an on-hook state (column 4, line 21 “before the called party answers”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system”), the method comprising the steps of:

receiving a digitized version of the message (column 4, line 25 “an ICLD signal”) during a silent interval following a ringing signal (column 4, line 27 “an ICLD signal transmitted between ring”) appearing at the called telephone apparatus (column 4, lines 25-49) [The ICLD signal is detected between ring signals before the called party answers the phone];

converting the digitized version of the audio message to an acoustic version thereof (column 5, lines 11-21) [The default action is taken to play the calling party audio inherently convert the ICLD]; and

introducing the acoustic version to a speaker (column 5, line 27 “a speakerphone”) to produce an audible version (column 5, line 27 “an audio”) of the audio message (column 5, lines 22-31) [The call is displayed and an audio announcement over the speakerphone to identify the calling party].

Regarding **claims 5, 8 and 11**, Horan discloses receiving a signal identifying the calling party during the silent interval following a first ringing signal appearing at the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 5, lines 22-31).

Regarding **claims 6, 9 and 12**, Horan discloses wherein the digitized version of the audio message is of sufficient duration to extend beyond the silent interval in which it begins (column 4, lines 25-49).

Regarding **claim 7**, Horan discloses calling party announcement systems (column 1, lines 6-9), (which reads on claimed “an apparatus for communicating an audio message (column 4, line 19 “audio message”) between a calling telephone apparatus (column 4, line 20 “calling party”) and a called telephone apparatus (column 4, line 20 “called party”) while the called telephone apparatus remains in an on-hook state (column 4, line 21 “before the called party answers”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system”), comprising:

a silence detector (130 on FIG. 1) detecting a silent interval following a ringing signal (column 4, line 27 “an ICLD signal transmitted between ring”) provided to the called telephone apparatus (column 4, lines 25-49) [The caller ID decoder includes circuitry to detect signals by initiating a frequency shift keying modem receiver]; and

a signal injector, (120 on FIG. 1) responsive to the silence detector, introducing a digitized version of the message (column 4, line 25 “an ICLD signal”) to the called

telephone apparatus during the detected silent interval (column 4, lines 25-49) [The ICLD signal is detected between ring signals before the called party answers the phone].

Regarding **claim 10**, Horan discloses calling party announcement systems (column 1, lines 6-9), (which reads on claimed “an apparatus for communicating an audio message (column 4, line 19 “audio message”) between a calling telephone apparatus (column 4, line 20 “calling party”) and a called telephone apparatus (column 4, line 20 “called party”) while the called telephone apparatus remains in an on-hook state (column 4, line 21 “before the called party answers”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system”), comprising:

a silence detector (130 on FIG. 1) detecting a silent interval following a second ringing signal (column 4, line 27 “an ICLD signal transmitted between ring”) provided to the called telephone apparatus (column 4, lines 25-49) [The caller ID decoder includes circuitry to detect signals by initiating a frequency shift keying modem receiver];

a receiver (100 on FIG. 1), responsive to the silence detector, receiving a digitized version of the message (column 4, line 25 “an ICLD signal”) at the called telephone apparatus during the detected silent interval (column 4, lines 25-49) [The ICLD signal is detected between ring signals before the called party answers the phone];

a digital-to-analog converter (120 on FIG. 4) converting the digitized version of the audio message to an audio version thereof (column 5, lines 11-21) [The default action is taken to play the calling party audio inherently convert the ICLD]; and

a speaker (column 5, line 27 "a speakerphone") responsive to the audio version to produce an audible version (column 5, line 27 "an audio") of the audio message (column 5, lines 22-31) [The call is displayed and an audio announcement over the speakerphone to identify the calling party].

### ***Response to Arguments***

4. Applicant's arguments with respect to **claims 1-12** have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reese is cited for a method for providing to a customer a promotional message between ringing signals (FIG. 1).

Itoh is cited for a terminal device for network system (FIG. 1).


Bleile is cited for a pre-ring caller identification apparatus (FIG. 1).



6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4800.

  
g.g.  
December 1, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

